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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,631	12/07/2000	Steven M. French	AUS920000800US1	1071
35525	7590	08/17/2011		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER NGUYEN, THANH T	
			ART UNIT 2448	PAPER NUMBER
			NOTIFICATION DATE 08/17/2011	DELIVERY MODE ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN M. FRENCH and LORIN E. ULLMANN

Appeal 2009-011097
Application 09/731,631
Technology Center 2400

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III,
and THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-23. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

A. INVENTION

Appellants' invention relates to a method and system for selecting an Operating System (OS) at a target device from a networked server; wherein, the target device sends a bootstrap list command to the server and receives a list of OS available for download (Abstract; Spec. 11:1-22).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary:

1. A method of selecting an operating system at a target device in communication with a server, comprising:

initiating a network bootstrap program at the target device;

sending a bootstrap list command from the target device to the server;

receiving an operating systems list of at least one operating system prior to executing an operating system at the target device; and

selecting a target operating system from the operating systems list, wherein the target device is to be remotely booted by the server.

C. REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Beelitz	US 6,182,275 B1	Jan. 30, 2001 (filed on Jan. 26, 1998)
Barr	US 6,189,100 B1	Feb. 13, 2001 (filed on Jun. 30, 1998)

Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beelitz in view of Barr.

II. ISSUES

The dispositive issues before us are whether the Examiner has erred in determining that the combination of Beelitz and Barr teaches or would have suggested:

1. “initiating a *network bootstrap program* at the target device,” “sending a bootstrap list *command from the target device to the server*,” and “receiving an *operating systems list* of at least one operating system prior to executing an operating system at the target device” (claim 1, emphasis added);
2. “*relocating the network bootstrap program* after the target operating system is selected” (claim 6, emphasis added)
3. “the target operating system is selected *by a user* of the target device” (claim 8, emphasis added); and
4. “determining from a *user profile*, at least one available operating system” (claim 9, emphasis added).

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Beelitz

1. Beelitz is directed to a system and method for generating a build-to-order computer system having compatible software; wherein, the system provides to a first list of options (preferably a list of Operating Systems (OSs)) at a user interface, receives from the user interface an indication of a selected choice, and generates a second list of software compatible with the user's selected choice (col. 2, ll. 20-51).

2. A control server 103 retrieves a first list of OS options available for the user to select from a master data base 125 and presents this list to the user at terminal 105(col.2, ll. 39-46; col. 4, ll. 10-27 and 40-49). After the user makes a choice, the control server 103 accesses the master data base 125 for a second list of software that is compatible with the OS and sends this list to the user (col. 2, ll. 39-46; col. 4, ll. 49-54).

3. The control server 103 generates a data file containing all of the user's selections to a manufacturing server having a parser that reads the data file and associates executable shell script files to execute the installation of the operating system and compatible software applications (Figs. 1, 2, 4, and 7; col. 5, ll. 6-15 and 35-43).

4. The target computer system 605 may invoke the software selection program (Figs. 2-5, similar to the control server 103) stored in the manufacturing server 610; wherein, the targeted computer system 605 is enabled to access the master data base 125 through a network connection 620 and retrieve lists of software programs that are compatible with the

previous selections made by the operator of the targeted computer system 605 to be displayed on the display screen (Figs. 1-5 and 7; col. 18, ll. 5-28).

5. The control server 103 may generate an system descriptor record (SDR) file as the data file; wherein, the SDR file is a computer readable text file that includes an entry or line for each hardware component, software program, patch, or other operation to be implemented on the targeted computer system 137, along with customer specific information such as the name and address of the computer purchaser (col. 13, ll. 42-47 and 55-57).

Barr

6. Barr is directed to a method for ensuring the integrity of remote client data that includes a remote boot process that remotely boots a client from a server on a network (Abstract).

IV. ANALYSIS

Claims 1-5, 7, 10-13, 15, 18-20, and 22

Appellants do not provide separate arguments with respect to independent claims 1, 11, and 18 (App. Br. 11-15). Further, Appellants do not provide separate arguments with respect to claims 2-5, 7, 10, 12, 13, 15, 17, 19, 20, and 22 depending from claims 1, 11, and 18. Accordingly, we select independent claim 1 as being representative of the claims. *See* 37 C.F.R. § 41.37(c)(1)(vii).

In the Supplemental Appeal Brief, Appellants contend that “Beelitz does not teach ... that the targeted computer system either ‘initiates a network bootstrap program at the target device’ or sends ‘a bootstrap list command from the target device to the server,’” since “Beelitz teaches that

the target computer system is ‘booted up to perform the operations and instructions as per associated shell scripts to load the selected programs onto its hard drive’” (Supp. App. Br.11-12). Appellants assert further that “Beelitz does not teach or suggest ‘receiving an operating systems list of at least one operating system prior to executing an operating system at the target device’” (Supp. App. Br. 12).

Appellants contend further that “Beelitz teaches away from the combination” in that “sending a list of available operating systems to a user who is purchasing a build-to-order computer [as taught by Beelitz] is dramatically different than sending a list of available operating systems *to* the build-to-order computer” or target computer as taught by Appellants (Supp. App. Br.12-13). Appellants also argue that “modifying the Beelitz system to feature the remote boot taught by Barr would entirely defeat the purpose of Beelitz, and cannot lead to any reasonable expectation of success” (Supp. App. Br. 13). Appellants finally assert that “[t]he mere fact that Beelitz can be modified in view of Barr to obtain the claimed invention (which Appellants deny) does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination” (Supp. App. Br. 14).

However, the Examiner notes that the Appellants’ arguments on pages 11-12 of the Brief are “insufficient to satisfy the requirement of specific argument to have the claims consider for patentability; [because] in accordance [with] 37 C.F.R. 57 [§] 1.111 Applicant[s] must distinctly and specifically point out ‘how the language of the claims patentably distinguishes them from the references’” (Ans. 8).

The Examiner finds further that the “Beelitz reference discloses the initiating [of] a network bootstrap program at the target device,” wherein “the targeted computer system 137 is initially booted up to perform the operation” (Ans. 8). Thus, it “would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the Barr’s [teaching] into the computer system of Beelitz ... because it would have ... provided an efficient system that lets a client and server to exchange a shared encryption key using the secure remote boot process” (Ans. 9-10).

To determine whether the combined teachings of Beelitz and Barr discloses “initiating a network bootstrap program at the target device,” “sending a bootstrap list command from the target device to the server,” and “receiving an operating systems list of at least one operating system prior to executing an operating system at the target device” as required by claim 1, we give the claim its broadest reasonable interpretation consistent with the Specification. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). However, we will not read limitations from the Specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Claim 1 does not place any limitation on what “network bootstrap program,” “bootstrap list command,” or “operating systems list” mean, include, or represent. Thus, we give “network bootstrap program” its broadest reasonable interpretation as *any* software related to the network that initiates system start-up of an operating system within a computer, as consistent with the Specification and as specifically defined in claim 1. Since the “bootstrap list command” is not related to any other step nor performs any computer function, we give “bootstrap list command” its broadest reasonable interpretation as *any* command issued from the target

device to the server, as specifically defined in claim 1. Finally, we give “operating systems list” its broadest reasonable interpretation as *any* list of software that controls the processes of a computer, as consistent with the Specification and as specifically defined in claim 1.

Beelitz is directed to a system and method for generating a build-to-order computer system having compatible software; wherein, the system provides a first list of options (preferably a list of Operating Systems (OSs)) at a user interface, receives from the user interface an indication of a selected choice, and generates a second list of software compatible with the user’s selected choice (FF 1). In particular, a control server presents the first list of OSs available for the user to select; and, after the user makes a selection, the control server sends to the user a second list of compatible software responsive to the user’s selection (FF 2). The control server generates a data file containing all of the user’s selections to a manufacturing server having a parser that reads the data file and associates executable shell script files to execute the installation of the operating system and compatible software applications (FF 3). Similar to the control server, *the target computer system* may execute a software selection program stored on *the manufacturing server* which enables the targeted computer system to access the master data base through a network connection (FF 4). The master data base sends the target computer lists of software programs that are compatible with the previous selections *made by the operator of the targeted computer system* for display on the display screen of the target computer (FF 4).

Accordingly, we find that the operator (user) of the target computer system may send a command for a first list of OSs and a second list of

compatible software using the software selection program disclosed in Beelitz. We find further that the target computer system may receive this list of OSs prior to the executing an OS at the target device. That is, in view of our claim construction above, we find Beelitz discloses that the target device sends a command to the server and receives an operating systems list prior to executing an operating system at the target device as required by claim 1.

Barr is directed to a secure remote boot process that remotely boots a client from a server on a network (FF 6). In view of our claim construction above, we find the remote boot of a client to be the network boot strap program that is initiated at a target device.

The Supreme Court has stated that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

Thus, we find no error in the Examiner’s ultimate legal conclusion that the combination of Beelitz’s method that enables an operator at the target computer system to initiate a software selection program (accessing OSs and compatible software) with a method of initiating a network remote boot, as disclosed in Barr, produces a method and system for selecting an OS at a target device, which would have been obvious (Ans. 4 and 9-10; FF 1-4 and 6).

Our reviewing court has held that “[a] reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the

applicant.” *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

Appellants have identified no express support for *a direction divergent* from the claimed invention since both Beelitz and Barr teach booting the target computer system.

We note that Appellants provide additional arguments in the Reply Brief (Reply Br. 4-6). However, since these arguments are new arguments raised for the first time in the Reply Brief that could have been raised in the Appeal Brief (but Appellants failed to do so), we deemed the arguments technically waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Accordingly, we find that Appellants have not shown that the Examiner erred in rejecting claims 1, 11, and 18 and claims 2-5, 7, 10, 12, 13, 15, 17, 19, 20, and 22 depending from claims 1, 11, and 18 under 35 U.S.C. § 103(a) over Beelitz and Barr.

Claims 6, 14, and 21

As for claim 6, Appellants contend that Beelitz does not teach “relocating the network bootstrap program after the target operating system is selected,” (claim 6) since “no such teaching is made” in the Examiner’s citation to Beelitz (Supp. App. Br. 15). Appellants assert that “Beelitz discloses creating a system descriptor file that includes the specific part number for the selected version and language of the selected operating system, including a prefix” which “simply cannot render” the claims obvious (Supp. App. Br. 15).

Although the Examiner finds that “Beelitz reference discloses relocating the network bootstrap program after the target operating system is

selected” since “the central master data base [maintains] the lists generated by the control computer systems [such that they are] compatible and [u]p-to-date” (Ans.10-11), we do not find any teaching of relocating the network bootstrap program after the target operating system is selected in the sections of Beelitz relied upon by the Examiner.

Accordingly, we find that Appellants have shown that the Examiner erred in rejecting claim 6 under 35 U.S.C. § 103(a) over Beelitz in view of Barr. Claims 14 and 21 (respectively depending from claims 11 and 18) similarly recite “relocating the network bootstrap program after the target operating system is selected.” Accordingly, claims 14 and 21 stand with claim 6.

Claims 8, 16, 17, and 23

Appellants do not provide separate arguments with respect to independent claims 8, 16, and 23 (App. Br. 15). Accordingly, we select independent claim 8 as being representative of the claims.

Appellants contend that Beelitz does not teach “the target operating system is selected by a user of the target device,” (claim 8) since “Beelitz discloses that the target operating system is determined by a system configuration, while the instant application claims that the target operating system is selected by a user” (Supp. App. Br. 15).

However, the Examiner finds that “Beelitz reference discloses the target operating system is selected by a user of the target device” since “the entry for an operating system may include a tag that indicates that the vendor offers a standard disk format with the operating system, the tag indicates the control system need[s] to be presented to user and that the user needs to select an option” (Ans.10).

Claim 8 does not place any limitation on what the term “user” means, includes, or represents. Thus, we give the term “user” its broadest reasonable interpretation as any operator of the target operating system, as consistent with the Specification and as specifically defined in claim 8.

As noted *supra*, Beelitz teaches that the operator of the target computer system may send a command to the manufacturing server to initiate the software selection program which enables the target computer to retrieve a first list of OSs and a second list of compatible software from the master data base (FF 4). Accordingly, we find Beelitz to disclose that the operator of the target computer system may select the OS.

Therefore, we find that Appellants have not shown that the Examiner erred in rejecting claims 8, 16, and 23 and claim 17 depending from claim 16 under 35 U.S.C. § 103(a) over Beelitz in view of Barr.

Claim 9

Appellants contend that Beelitz does not teach “determining from a user profile, at least one available operating system” (claim 9) since “Beelitz merely discloses that a master database is consulted ... at a server” and “[n]o user profile is disclosed” (Supp. App. Br. 15).

However, the Examiner finds that the “Beelitz reference discloses a user profile” because Beelitz teaches “SDR files [that] include customer specific information such as the name and address” (Ans. 10).

Claim 9 does not place any limitation on what the term “user profile” means, includes, or represents. Thus, we give the term “user profile” its broadest reasonable interpretation as *any data file* that contains information *relative to any user* of the system, as consistent with the Specification and as specifically defined in claim 9.

As noted *supra*, Beelitz is directed to a system and method for generating a build-to-order computer system having compatible software (FF 1). The control server 103 may generate an SDR file as the data file; wherein, the SDR file is a computer readable text file that includes a list of hardware and software components to be implemented on the targeted computer system, along with *customer specific information such as the name and address of the computer purchaser* (FF 3 and 5). In view of our claim construction above, we find the SDR file to be a data file that contains information relative to the user.

Accordingly, we find that Appellants have not shown that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 103(a) over Beelitz in view of Barr.

V. CONCLUSION AND DECISION

The Examiner's rejection of claims 1-5, 7-13, 15-20, 22, and 23 under 35 U.S.C. § 103(a) is affirmed. The Examiner's rejection of claims 6, 14, and 21 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART